



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : DiPoto et al.

Art Unit : 3731

Serial No. : 09/447,228

Examiner : G. Jackson

Filed : November 22, 1999

Title : SUTURE ANCHOR AND DRIVE ASSEMBLY

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO ACTION OF AUGUST 1, 2005

In reply to the Final Office Action of August 1, 2005, Applicant submits the following remarks.

Claims 1-19, 21-71, 73-88, 94-99, and 102-110 stand rejected under 35 USC 251 as being an improper recapture of surrendered subject matter in view of the 08/091,092 and 08/509,966 applications, which issued as U.S. Patent No. 5,690,676 ("the '676 patent"). Applicants continue to traverse the rejection, the Examiner's characterization of the claims and the prosecution histories, and the application of the elements set forth in *Pannu*.

First, the Final Office Action does not establish that the reissue claims improperly recapture surrendered subject matter because the Office Action fails to perform an analysis of the third element of *Pannu*, namely, to determine whether the claims are materially narrower in aspects other than the surrendered subject matter so as to escape the recapture rule. Instead, the Office Action erroneously applies a per se rule that any claim without a limitation added during prosecution is impermissible, regardless of whether the claim is materially narrower in aspects unrelated to the surrendered subject matter.

However, in *Ex Parte Eggert*, the Board of Patent Appeals and Interferences (BPAI) explicitly rejected such a per se rule. *Ex Parte Eggert*, Appeal No. 2001-0790, attached, at page 14.

Specifically, the Examiner's Final Office Action states:

Applicants' attention is directed to the third element of the general claim limitation recited on page 3 [of the previous Office Action] representing claims in the '092 and '966 applications. This limitation is considered the surren-